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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,311	02/11/2004	Anthony J. Kinney	BB1538USNA	4023
23906 7590 07/05/2007 E I DU PONT DE NEMOURS AND COMPANY LEGAL PATENT RECORDS CENTER BARLEY MILL PLAZA 25/1128 4417 LANCASTER PIKE WILMINGTON, DE 19805			EXAMINER FOX, DAVID T	
			ART UNIT 1638	PAPER NUMBER
			MAIL DATE 07/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/776,311	Applicant(s) KINNEY ET AL.	
	Examiner David T. Fox	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,11,12,16-18,21-28 and 140 is/are pending in the application.
- 4a) Of the above claim(s) 21-25 and 140 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,11,12,16-18 and 26-28 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>23 March 2007</u> . | 6) <input type="checkbox"/> Other: _____ |

Request for Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 23 March 2007 has been entered, as requested by the RCE of 23 April 2007.

Applicant's amendments of 23 March 2007 have overcome the objection of claim 12 regarding abbreviations, and the outstanding rejection under 35 USC 101.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

Claims 1, 11-12, 21 and 26-28 are objected to for failing to comply with proper amendment format, per 37 CFR 1.121(c). Claims 1, 11 and 26-27 recite an improper claim status identifier ("previously amended" versus the correct ---previously presented---). Claims 21 and 28 are incorrect in their indication of current amendment where no contemporaneous amendment had occurred. Claim 12 is objected to for its failure to underline newly added material in claim 12 ("docosahexaenoic acid"), and its misspelling of an original claim term ("EOPA" versus ---EPA---). In the interest of compact prosecution, the claims have been treated on the merits. Such treatment does not relieve Applicant of their responsibility to respond to these objections.

Obviousness-Type Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 11-12, 16-18 and 26-28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 11-12, 16-18 and 26-28 of copending Application No. 11/624,777. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to utilize the oilseed plants and seeds containing at least 1% of at least one polyunsaturated fatty acid having at least twenty carbon atoms and at least five carbon-carbon double bonds, as claimed in the copending application; to obtain the transgenic oilseed plants and seeds containing at least 1% of at least one polyunsaturated fatty acid having at least

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twenty carbon atoms and at least five carbon-carbon double bonds. Since plants do not naturally produce such long-chain fatty acids, one of ordinary skill in the art would have recognized that the oilseed plants and seeds in the copending application were transgenic, or that transgenes would have been required. The claims are coextensive.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Enablement

Claims 1, 11-12, 16-18 and 26-28 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for claims limited to soybean plants transformed with particular genes encoding particular enzymes which produce oil having a particular fatty acid profile; does not reasonably provide enablement for claims broadly drawn to any oilseed plant containing any transgene and producing oil exhibiting any fatty acid profile. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims, as stated on pages 4-6 of the Final Rejection mailed 25 January 2007.

Written Description

Claims 1, 11-12, 16-18 and 26-28 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention, as stated on page 6 of the Final Rejection mailed 25 January 2007.

Applicant's Arguments

Applicant's arguments filed 23 March 2007, regarding the written description and enablement rejections, have been fully considered but they are not persuasive.

Applicant urges that the Kinney declaration of 23 March 2007 and appended references obviate the outstanding rejections under 35 USC 112, first paragraph.

The Kinney declaration of 23 March 2007 is not persuasive because it remains unclear whether the references cited utilized the techniques and constructs taught in the specification. It appears that the references support the Examiner's position regarding unpredictability, specifically regarding the suitability of particular plant species for the claimed high (above 1%) levels of long-chain fatty acids, particularly for DHA, in contrast to the claim breadth reciting any oilseed plant species. See Wu et al (2005) page 1014, column 1, second full paragraph and page 1015, column 1, second full paragraph. See also Damude et al (2007), fourth page, column 2, first full paragraph and fifth page, column 1, second full paragraph. See also Napier et al (2006), page 401, column 1, first full paragraph and column 2, top paragraph and bottom paragraph; and page 403, column 1, last sentence and column 2, top paragraph and first sentence of second paragraph.

The art cited by Applicant also supports the Examiner's position that the particular combination of enzymes (and genes encoding them) utilized by Applicant was essential for the production of the claimed high levels of long chain fatty acids. See

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Damude et al, fifth page, column 1, third full paragraph. See also Napier et al, page 402, column 2, bottom paragraph.

The art cited by Applicant also appears to indicate that particular new genes or enzymes were required for the obtention of high levels of long-chain fatty acids in a variety of non-exemplified oilseed plant species, which genes or enzymes were not taught or contemplated by the instant specification. See Napier et al, page 400, column 2, bottom paragraph, penultimate sentence. See also Wu et al, page 1013, column 2, bottom paragraph; page 1014, column 1, second full paragraph. See also Damude et al, fourth page, column 2, second full paragraph, penultimate sentence

Regarding the statements on page 2 of the Kinney declaration, penultimate paragraph, it is noted that none of the claims are limited even to the presence of the very broad class of desaturase and elongase genes. It is also noted that this discussion does not refer to the third type of long-chain fatty acid which is claimed, namely DPA. It is also noted that most of the claims are not even limited to any particular long-chain fatty acid (claims 1, 16 and 26), or even to particular omega-3 fatty acids (claims 11, 17 and 27).

Conclusion

The claims remain free of the prior art, as stated previously.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (571) 272-

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0795. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached on 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 23, 2007

DAVID T. FOX
PRIMARY EXAMINER
GROUP ~~180~~ 1638

